



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,510	03/04/2005	Martin Gerard Rene Bosma	TS6387 US	3611
23632	7590	12/06/2006	EXAMINER	
SHELL OIL COMPANY P O BOX 2463 HOUSTON, TX 772522463			ANDREWS, DAVID L	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/526,510	Applicant(s) BOSMA ET AL.	
	Examiner David Andrews	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/4/2005 and 12/7/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

The preliminary amendment dated 3/4/2005 has been entered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: wellbore bottom 8, page 3, line 26. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 12 is objected to for the phrase "or the like" which renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. Further in claim 12, line 2, the recitation "from the group" should be changed to --from the group consisting of-- in order to properly claim a Markush grouping. Later in claim 12, "Sodium Bentonite" should not be capitalized as only the first word of a claim is capitalized. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 9 and 11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kilaas et al. (US 6,672,385). Kilaas et al. disclose a wellbore device comprising: multiple fluid passages (10 in figure 6), a body of swellable material as a sleeve with an open weave structure (8 in figure 6) wherein fluid contact substantially closes the fluid passages (column 4, lines 29-46), a filter (7 in figure 6) inside of the sleeve, wherein the device is adapted to be arranged in a wellbore formed in an earth formation (1 in figure 1), wherein certain fluid passages are closed due to contact with fluid and others remain open (closed passages 5 in figure 4), wherein the body is formed as a tube (figures 4 and 5), and wherein the activation fluid is formation water (column 2, lines 45-50; see description of ambient water).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Kilaas et al. Kilaas et al. disclose all the limitations of claims 6 and 7 except for disclosing a perforated conduit inside of the sleeve of swellable material. Kilaas et al. do disclose a perforated conduit (6 in figures 3-10), but place it on the outside of the filter and the swellable sleeve. However, the alternate layering of these structures is seen as obvious in view of Kilaas et al., who does allow for variations (as in the present application the particular organization solves no stated problem. Therefore it would have been obvious to one of ordinary skill in the art at the time to modify the wellbore device of Kilaas et al. by alternating the order of layering of the components.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilaas et al. in view of Donnelly et al. (US 5,901,789). Kilaas et al. disclose all the limitations of claim 8 except for a radially expandable perforated tubular conduit. Such expandable screens are well known in the art, one such device is disclosed by Donnelly et al. as expanded and in contact with the borehole wall (figure 6). As described by Donnelly, expanding screens add the benefit properly screening wells with irregular borehole surface or sharp bends (column 1, lines 26-37). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to combine the wellbore

Art Unit: 3672

device of Kilaas et al. with the expandable screen of Donnelly et al. in order to alleviate the problem of irregular borehole surfaces.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kilaas et al. in view of Dalrymple et al. (US 6,364,016). Kilaas et al. disclose all the limitations of claim 12, except for explicitly naming the water swellable materials their matrix is comprised of, although they do describe them in general terms (column 7, lines 43-56; column 8, lines 1-17). Dalrymple et al. disclose a method of reducing water permeability in wellbores with specific substances including vinylacetate-acrylate copolymer and carboxymethyl cellulose polymers (column 3, lines 46-61). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the wellbore device of Kilaas et al. with the polymers of Dalrymple et al. in order to use substances known in the art to have the water permeability reducing properties necessary to limit water production.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Restarick (US 5,355,956) discloses a perforated conduit with perforation sealing features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Andrews whose telephone number is (571) 272-6558. The examiner can normally be reached on Monday-Thursday, 7:30am-5pm and alternate Fridays.

Art Unit: 3672

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DLA
11/28/06